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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,016	02/20/2003	Elazar Sonnenschein	A34908PCTUSA;066031.0169	5998
21003	7590	04/07/2005	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			LEUBECKER, JOHN P	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

2P

Office Action Summary	Application No. 10/030,016	Applicant(s) SONNENSCHN ET AL.	
	Examiner John P. Leubecker	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The disclosure is objected to because of the following informalities: page 12, the Brief Description of the Drawings does not include a description of Figure 9C.

Appropriate correction is required.

Claim Objections

2. Claim 12 is objected to because of the following informalities: in claim 12, “ocular” should be –ocular–. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, term “the sheath...adjacent to or located proximally of said articulation section” lacks antecedent basis. Although it is reasonable to interpret the articulation section as inherently having a proximal end, it would not automatically occur to anyone that the sheath has a portion adjacent to or proximally of the articulation section, unless specifically recited. Note that only a “sheath provided with a distal articulation section” is previously claimed.

As to claim 3, “display apparatus” lacks antecedent basis.

As to claim 14, reference to “the display” makes the claim indefinite since it infers that

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the display apparatus might be required by the claim, yet such has not be explicitly recited as part of the claimed combination.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-6 and 8-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuramoto et al. (U.S. Pat. 5,395,030) for the reasons set forth in numbered paragraph 9 of the previous Office Action, paper number 08052004.

As previously pointed out, the first location is the location of objective lens (144, Fig.22) and the second location is the location of the second objective lens (122, Fig.22). As to new claim 11 and as pointed out previously, note anvil (146) and stapling device (124). As to new claim 12, note ocular (10, Fig.2) which is also assumed as the means for viewing the addition image formed by the second objective lens. This ocular also forms a “coupling lens” if a camera is attached (it is noted that claim 12 does not require an image sensor or a display apparatus, just a lens that is suitable to deliver an image to such). With respect to claim 13, as previously pointed out, all optical elements have fixed focal lengths. As to claim 14, since there is nothing disclosed to prevent an image from being formed and transmitted in both objective lenses (144, 122) simultaneously, both will be displayed acquired and displayed simultaneously (again it is noted that the “display apparatus” has not be claimed as part of the combination). As to claim

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15, note circular objective lenses (122,144) which will inherently produce a circular field of view.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over El Gazayerli (6,159,146) in view of Kuramoto et al. for the reasons set forth in numbered paragraph 12 of the previous Office Action, paper number 08052004.

9. Claims 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuramoto et al. in view of Cherry et al. (U.S. Pat. 5,693,968).

Although Applicant's specification does not disclose how or where along the optical system a non-circular (rectangular) field of view is formed, this aspect can be attributed to many features including the shape of any of the lenses (e.g., objective, ocular, coupling), shape of the optical relay system (e.g., optical fiber bundle), shape of field stops or aperture stops, and shape of the electronic imaging device if used (e.g., most CCDs are rectangular by design). Kuramoto et al. disclose an alternative observation system including a CCD device (col.26, lines 3-5).

Since no particular CCD device is specified, it would have been obvious to one of ordinary skill to use a conventional CCD device to acquire the image. Cherry et al. teaches that a conventional

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CCD has a rectangular array of pixels (col.1, lines 40-41). Thus, at least at the image sensor, the field of view would be rectangular.

10. Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over El Gazayerli in view of Kuramoto et al. and further in view of Uehara et al. (U.S. Pat. 5,609,561).

El Gazayerli disclose a generic endoscope device and suggests such is capable of providing a video image (col.5, lines 66-67) yet no specifics are disclosed. One of ordinary skill would obviously turn to what is known in the prior art to “fill in the gaps” with respect to any specific endoscope structure. Uehara et al. is just one of many known endoscope devices that teaches such conventional features as an optical relay (53, Fig. 1), an ocular of fixed focal length (54, Fig. 1), a coupling lens of fixed focal length (55, Fig. 1) (although not required by the claim, note image sensor 56 and display apparatus 37), and a circular field of view (at least at the distal end due to circular objective lenses). As mentioned immediately above, a conventional rectangular CCD would provide for a rectangular field of view. It would have been obvious to one of ordinary skill in the art to have used any known endoscope device as the generic endoscope device of El Gazayerli.

Response to Arguments

11. Applicant's arguments filed January 6, 2005 have been fully considered but they are not persuasive.

Regarding the Kuramoto reference with respect to claims 1-7, it appears that Applicant's objection to this reference depends on the fact that the insertion section 42 is “movable” with

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respect to the insertion section (137). Since the language of claim 1 does not exclude such structure, this argument is considered moot.

Regarding claim 8, it appears Applicant's objection to use of this reference to meet the limitations of claim 8 stem from the fact that certain structures in Kuramoto (i.e., Fig. 34) are not labeled as Applicant would like them to be. Particularly, since element (166) is called a "suction device" and element (172) is called a "guide pipe", Applicant contends that the limitations of claim 8 are not met. The Examiner can find no basis or merit to this argument and is not even sure how to respond to this. Either the distal end of element (165) or (166) can be considered a "distal tip or an endoscope" and the guide tube (172) provides a space that is "suitable to receive" anvil shaft (173). It does not get any clearer than that.

Regarding Figure 22 of Kuramoto, the Examiner takes the position that as broadly as claimed, the elements of Figure 22 meet the limitations of claim 8. Although Applicant suggests that the stapler holder (124) is permanently attached to the distal end, no evidence is provided for such conclusion. Instead, it would appear that analogous structure would be similar to that of Figure 1 which shows a socket (30) capable of receiving a stapler holder.

Regarding the rejection of El Gazayerli in view of Kuramoto et al., Applicant argues that the proposed combination does not disclose or suggest a "single shaft". Since the language of claim 1 does not require such structure, this argument is considered moot.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ouchi (U.S. Pat. 6,547,723)--note embodiment shown in Figure 2 which would anticipate at least claim 1.

Okada (U.S. Pat. 5,871,440)—note rectangular field of view (322', Fig.31A) caused by shape of objective lens 322.

Terada et al. (U.S. Pat. 4,872,740)—note teaching that the image fiber bundle can be rectangular, circular, or non-circular (col.5, lines 21-25).

Adair (U.S. Pat. 5,929,901)—note teaching to use a rectangular CCD or a circular one (Fig.1b, elements 40 and 40').

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

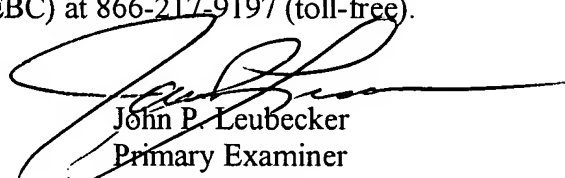
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769.

The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl